

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

BALL

Serial No.: 10/721,694

Filed: November 25, 2003

Atty. File No.: 5564-138B

For: "Cap for Sealing a Bathtub Overflow  
Port for Testing Purposes"

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

) Group Art Unit: 3751

) Examiner: Robert M. Fetsuga

) Confirmation No.: 6303

) REASONS IN SUPPORT OF PRE-  
APPEAL BRIEF REQUEST FOR REVIEW

Certificate of E-Filing

I Hereby Certify That this Correspondence Is Being E-  
Filed with the United States Patent and Trademark Office  
on February 26, 2008.

BY:  SHERWAN ROSS P.C.

Dear Sir:

Applicant submits this paper in conjunction with the Pre-Appeal Brief Request for Review. It is respectfully submitted that the rejections to pending Claims 5, 8 and 21-24 of the above-identified application are clearly not proper and are without basis and therefore should be withdrawn.

Claims 5 and 8 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,470,437 to Rabinovich ("Rabinovich"). Claims 5, 8 and 21-24 have been rejected under 35 USC §103 as being unpatentable over a combination of U.S. Patent No. 6,484,331 to Minnick ("Minnick") and U.S. Patent No. 5,890,241 to Ball ("Ball").

These rejections were addressed in an Amendment and Response dated July 26, 2007 and in an Amendment and Response After Final dated January 3, 2008. The Examiner addressed the latter in an Advisory Action dated January 28, 2008. The Advisory action indicated that the rejections of Claims 5 and 7 under 35 U.S.C §112 were overcome by the Amendment and Response After Final. The drawings presented in that Amendment were also accepted. The Examiner has indicated that the specification objection concerning claim 5 was not addressed. Finally, the Examiner has asserted that Claims 5 and 21 as amended in the Amendment and Response dated July 26, 2007 "differ materially" from those indicated allowable in a non-final Office Action Summary dated March 27, 2007 (Claims 6 and 9). The Amendment and Response After Final included a

restatement of the claims, but no claim amendments. The objection, rejections and the ongoing behavior of Examiner Fetsuga will be addressed in turn below.

***Finality of the August 27, 2007 Office Action***

Applicant traverses the finality of the August 27, 2007 Office Action Summary. Detailed arguments related to this issue were presented in the Amendment and Response After Final. Briefly, the Amendment and R dated July 26, 2007 included no substantive claim amendments. In the final Office Action Summary dated August 27, 2007, the Examiner raised a new ground of rejection to the claims based on Rabinovich and finally rejected the pending claims. The Examiner must be well aware that, generally, second or any subsequent actions on the merits shall be final, *except where* the examiner introduces a new ground of rejection. Since, as outlined in the Amendment After Final and will be reiterated below, the Applicant simply redrafted objected-to claims in independent form and addressed minor issues related to 35 U.S.C. §112 Office Action Summary dated August 27, 2007 should not have been final.

**Specification Objection**

The Examiner states in the Advisory Action dated January 28, 2009 that the specification objection concerning the lack of antecedent basis for the last two lines of Claim 5 was not addressed. The last two lines of Claim 5 were taken from previously allowable Claim 6, wherein no such rejection was put forth. Applicant points to the Amendment and Response dated July 26, 2007 wherein a prior rejection of Claim 6 for lack of antecedent basis was addressed. In that amendment the specification and figures were amended to provide the required antecedent basis for the subject matter of Claim 6, which is now found on Claim 5.

**Claim Rejections under 35 U.S.C. §102 - Rabinovich**

The Advisory Action dated January 28, 2007 was silent as to Applicant's arguments regarding newly-cited Rabinovich. Thus, it is believed that the Examiner is maintaining various rejections related thereto. Applicant incorporates by reference the arguments made in the Amendment. Specifically, Rabinovich does not teach each and every one of the claimed elements of rejected Claims 5 and 8.

### **Claim Rejections under 35 U.S.C. §103 - Minnick and Ball**

Applicant continues to traverse the rejection of Claims 5, 7, 8 and 21-24 as being obvious in view of a combination of Minnick and Ball. The subject matter of Independent Claims 5 and 21 was previously allowed over a combination of Minnick and Ball. More specifically, in the non-final Office Action Summary dated March 27, 2007 the Examiner indicated that dependent Claims 6 and 9 would be allowable if rewritten in independent form. Applicant adopted the Examiner's suggestion and amended Independent Claim 5 by adding the subject matter of Claim 6. The subject matter of Claim 9 was added to the subject matter of Claim 5 to form new Claim 21.

The Examiner states in the Advisory Action dated January 28, 2008 that pending claims 5 and 21 "differ materially" from Claims 6 and 9 that were previously indicated as allowable. Below is a comparison of currently rejected Claim 5 and previously allowable Claim 6. In addition, a comparison of currently rejected Claim 21 and previously allowable Claim 9 is provided. Review will show that the claim amendments simply added the allowable subject matter from Claim 6 and Claim 9 to Claim 5 and Claim 21, respectively.

In addition, a portion of the claims that reads "cap threadingly engaged" was moved to render the claims more coherent. More specifically, the beginning of Claim 5 stated that the cap was "interconnected" to the pipe. The last line of Claim 5 further limited the interconnection method wherein the cap is claimed to be "threadingly engaged" to the pipe. Thus no material change was made.

Finally, the portion of Claim 5 that stated "and said flange" shown marked by an asterisk (\*) was removed as being redundant. More specifically, the subject matter taken from Claim 6 and added to Claim 5 required that the membrane be interconnected to the face and the flange, stated differently, the requirement that the outer surface of the flange be coincident with the outer surface of the membrane must mean that the membrane is interconnected to the face and the flange. Thus stating that the membrane was "affixed to said face and said flange" was redundant.

Similarly, Claim 21 states that the membrane is affixed to the face (54 of Fig. 2) and such that the open end of the cap is sealed. Thus the open end and the face must be associated. In addition, the claim requires that a flange extends radially outwardly from the open end and that a second radial flange extends inwardly from the open end. Thus the flanges must be associated with

the open end and the face. The membrane, as shown in Fig. 3, covers at least the inner flange and the face and seals the open end.

- Rejected Claim 5 compared to Allowable Claim 6

5. (Currently Amended) An overflow system for a bathtub comprising:  
 a pipe;  
 a cap threadingly engaged interconnected to said pipe, said cap having a cylindrical body bounded by an outer face, said cylindrical body having interior threads and an annular flange that extends radially outwardly from an open end of the cylindrical body;  
 a membrane affixed to said face and said flange to seal said open end of said cap, wherein said membrane is positioned substantially entirely on said face and has an outer surface coincident with an outer surface of said flange; and  
 wherein said cap threadingly engages said pipe.

\*\*\*\*\*

5. An overflow system for a bathtub comprising:  
 a pipe;  
 a cap interconnected to said pipe, said cap having a cylindrical body bounded by an outer face, said cylindrical body having interior threads and an annular flange that extends radially outwardly from an open end of the cylindrical body;  
 a membrane affixed to said face and said flange to seal said open end of said cap; and  
 wherein said cap threadingly engages said pipe.

6. The system of Claim 5 wherein said thin membrane is positioned substantially entirely on said face and has an outer surface coincident with an outer surface of said flange.

- Rejected Claim 21 compared to Allowable Claim 9

21. (New) An overflow system for a bathtub comprising:  
 a pipe;  
 a cap threadingly engaged to said pipe, said cap having a cylindrical body bounded by an outer face, said cylindrical body having interior threads and an annular flange that extends radially outwardly from an open end of the cylindrical body;  
 a membrane affixed to said face to seal said open end of said cap; and  
 a second annular flange that extends radially inwardly from said open end of the cylindrical body.

\*\*\*\*\*

5. An overflow system for a bathtub comprising:  
 a pipe;  
 a cap interconnected to said pipe, said cap having a cylindrical body bounded by an outer face, said cylindrical body having interior threads and an annular flange that extends radially outwardly from an open end of the cylindrical body;  
 a membrane affixed to said face and said flange to seal said open end of said cap; and  
 wherein said cap threadingly engages said pipe.

9. The system of Claim 5, further including a second annular flange that extends radially inwardly from said open end of the cylindrical body.

**Examiner Fetsuga**

Attention is directed to arguments already of record in the Petition to Withdraw Holding of Abandonment filed in related application Serial Number 10/247,247, entitled "Cap for sealing a bathtub overflow port for testing purposes". In such petition, Applicant requested that Examiner Fetsuga be removed as the examiner of the related application. Applicant requests that the statements regarding Examiner Fetsuga be considered in light of the instant application as well.

**Conclusion**

Based upon the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 

Craig W. Mueller  
Registration No. 52,055  
1560 Broadway, Suite 1200  
Denver, Colorado 80202-5141  
(303) 863-9700

Date: February 26, 2008

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>5564-138B</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>2-26-08</u> Signature <u>C. W. Mueller</u> Typed or printed name <u>CRAIG W. Mueller</u>		Application Number <b>10/721,694</b>	Filed <b>11-25-2003</b>
First Named Inventor <b>BALL</b>		Examiner <b>FETSUGA</b>	
Art Unit <b>3751</b>		Examiner <b>FETSUGA</b>	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
 Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
 (Form PTO/SB/95)

☒ attorney or agent of record.  
 Registration number 52455

☐ attorney or agent acting under 37 CFR 1.34.  
 Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
 Signature  
CRAIG W. MUELLER  
 Typed or printed name  
343-863-2983  
 Telephone number  
2-26-08  
 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.